Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte RICHARD D. J. BIELINSKI and WILLIAM E. WATERS

Appeal No. 2003-0491
Application No. 09/584,173

ON BRIEF

Before COHEN, MCQUADE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-4, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to holders for fishing rods which provide means for automatically setting the hook at the end of the fishing line when a fish strikes the bait. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Becker et al. (Becker)	975,822	Nov. 15, 1910
Creviston et al. (Creviston)	3,550,302	Dec. 29, 1970
Moisan	4,573,281	Mar. 4, 1986
Smoluk	4,912,870	Apr. 3, 1990

The following rejections are before us for review.

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Smoluk.

Claims 2-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Smoluk in view of Moisan.

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Becker in view of Creviston.[1]

Claims 2-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Becker in view of Creviston and Moisan.

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[1] The examiner's reference to claims 2-4 in the answer was clearly an inadvertent error.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 12) for the examiner's complete reasoning in support of the rejections and to the brief (Paper No. 11) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. For the reasons which follow, we cannot sustain any of the examiner's rejections.

The Smoluk rejections

Claim 1 is directed to a fish-activated hook-setting assembly adapted for use with unattended fishing poles comprising, inter alia, a pole holding means attachable to the base and coactive therewith to support a fishing pole therein. Smoluk discloses an ice fishing apparatus comprising a base 12, an arm 30 extending outwardly from the base and spool 32, having a supply of fishing line 10 thereon, mounted on the arm 30. The fishing line 10 is fed through guides on the base 12. Smoluk does not teach a fishing pole or any structure used for holding a fishing pole. In rejecting claim 1 as being anticipated by Smoluk, the examiner has taken the position that the base 12, arm 30 and spool 32 define a pole holding means (answer, page 4). Specifically, the examiner (answer, page 7) states that

> [t]he reel (32), arm (30), and base (12) of Smoluk form an area or open space defined therebetween that is capable of receiving and holding a fishing pole therein. Similarly as appellant's holder (40) receives the pole in a slanted position, the rod holding structure of Smoluk is capable of receiving the rod in a slanted position. Appellant has not recited the particulars with regard to the pole holding member in such a manner which overcomes the Smoluk reference. Appellant **has not particularly claimed** the pole holding means comprising an outwardly extending bar defining a notch therein for receiving the pole **in combination with a fishing pole**. It is the Examiner's position that the Smoluk reference meets the limitation of pole holding means since the structure of Smoluk is perfectly capable of performing the functional language as recited.

The examiner's position with regard to the pole holding means limitation is not well taken. From our perspective, one of ordinary skill in the art viewing the Smoluk disclosure would not consider the base 12, arm 30 and spool 32 to define a pole holding means. We note further that claim 1 recites a pole holding means to support a fishing pole therein, which is limited, under the provisions of the sixth paragraph of 35 U.S.C. § 112, to the structure described in appellants' specification and equivalents thereof. The examiner has not pointed out the corresponding structure described in appellants' specification for performing the pole holding function and has not explained either how the referenced structure in Smoluk responds to such structure or the basis for concluding that it is an equivalent thereof.

To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. Karsten Mfg. Corp. v.

Cleveland Golf Co., 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Inasmuch as we agree with appellants that Smoluk lacks a teaching of a pole holding means, we conclude that the subject matter of claim 1 is not anticipated by Smoluk. We thus cannot sustain this rejection.

We also cannot sustain the rejection of claims 2-4, which depend from claim 1, as being unpatentable over Smoluk in view of Moisan. Moisan, relied upon by the examiner for its teaching of using a rubber grip material for holding fishing line, does not cure the above-noted deficiency of Smoluk.

The Becker in view of Creviston rejections

Becker discloses an automatic fish catching device into which fishing line 15 is fed. When a fish grasps the hook on the end of the line, a spring-loaded lever 5 is released from its position shown in Figure 1 in which it is latched to the vertical limb 3 and swings to the lowered position shown in Figure 2. The examiner concedes that Becker lacks a pole holding means. In view of the teachings of Creviston of the attachment of a fishing pole to an automatic motion lure and alert, the examiner determined that it would have been obvious to modify Becker's device such that a rod holder is employed in order to secure a fishing rod in close proximity to the hook setting device so that the angler may retrieve the fish quickly upon being hooked and also to

provide means to prevent a rod from falling to the ground or into the water (answer, page 5).

As stated by our reviewing court in In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000):

> Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant [citations omitted].

In this instance, we find no suggestion in Becker or Creviston to make the modification to Becker proposed by the examiner. Becker is directed to an automatic fish catching device which operates to pull the line to set the hook in the fish's mouth to catch the fish when a fish tugs on the line, while Creviston is directed to a lure and alarm device for periodically imparting motion to the fishing line and for activating an alarm when a fish pulls on the line. As disclosed by Creviston in column 4, lines 17-24, the reel 90 on fishing pole 12 may be of a conventional manual type which permits the fisherman to reel in the catch after being alerted to a bite or reel 90 may be a spring-loaded reel, known in the art, including a latch mechanism for automatically reeling in the fish after the fish has exerted a pull on the line. It is not apparent to us why one of ordinary skill in the art reading the disclosures of both Becker and Creviston would have been led to attach a fishing rod to the device of Becker. Rather, Creviston would

appear to us to have suggested to one of ordinary skill in the art, seeking to utilize a fishing rod to automatically set a hook in a fish's mouth and catch the fish after the fish has pulled on the line, provision of a spring-loaded reel on a fishing rod for achieving such purpose. In light of this simple solution proposed by Creviston, there would appear to be no reason to modify the Becker device so as to mount a fishing pole thereto.

For the foregoing reasons, the examiner's rejection of claim 1 as being unpatentable over Becker in view of Creviston appears to stem from impermissible hindsight[2] using appellants' disclosure as a template to reconstruct the invention of claim 1. Accordingly, we cannot sustain this rejection.

Moisan provides no cure for the above-noted deficiency of the combination of Becker and Creviston. It thus follows that we shall also not sustain the rejection of claims 2-4 as being unpatentable over Becker in view of Creviston and Moisan.

CONCLUSION

[2] Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

To summarize, none of the examiner's rejections is sustained. The decision of the examiner to reject claims 1-4 is reversed.

REVERSED

IRWIN CHARLES COHEN Administrative Patent Judge	)
JOHN P. MCQUADE Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)

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